

## REMARKS

Claims 20-34 and 37 are pending in the present application. Claims 35, 36, 38, and 39 are withdrawn from further consideration.

### Restriction Requirement

The Examiner found Applicant's arguments over the Restriction Requirement unpersuasive and deemed the requirement to be proper. According to the Examiner, the invention will encompass all compounds that fall within the scope of the search is[sic] as follows:

A compound of the formula (I) wherein:  
A is a radical of the formulae  $A^2$ ,  
m is as claimed except "0",  
n is as claimed except "0",  
X is limited to sulfur,  
 $R^1$  and  $R^2$  are as claimed,  
 **$R^3$  and  $R^4$  are as claimed except "hydrogen"** and  
all other variables are as defined.

Office Action, pages 4-5 (emphasis added).

However, Applicants elected the compound of Example 70, which "corresponds to the compound of Formula I wherein . . . each of  $R^3$ ,  $R^4$ , . . . is H[.]" Reply to Restriction Requirement, dated January 29, 2009 (emphasis added). By limiting  $R^3$  and  $R^4$  of the examined compounds of formula (I) as being "as claimed except 'hydrogen'," the Examiner is impermissibly excluding the elected species from examination. Under MPEP 803.02, "[t]he Markush-type claim would [] be **examined fully with respect to the elected species**. . . [S]hould the examiner determine that the elected species is allowable, the examination of the Markush-type claim will be extended." Emphasis added. Applicants assert that the examined invention must encompass the elected species. Applicants respectfully request that the Examiner withdraw this additional limitation.

### Rejection under 35 U.S.C. §102

The Examiner rejected claims 20-34 under 35 U.S.C. §102(b) as being anticipated by Kaye et al., (1952) ("Kaye"). Applicants traverse this rejection.

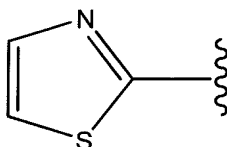
According to the Examiner,

Applicant claims substituted 1-(Azolin-2yl)amino-1,2-diphenylethane compounds, composition and the method of use thereof. Kaye et al. also disclose the synthesis of several

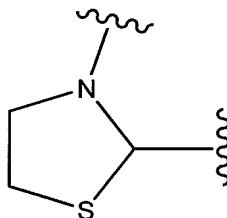
substituted amino-1,2-diphenylethyl compounds and at least one of them anticipates the instantly claimed invention[.]

Office Action, page 5, last paragraph. Applicants disagree.

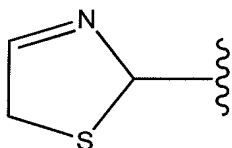
*Kaye* discloses compounds containing a thiazol-2-yl group having the following structure



By contrast, the claimed compounds can only contain an N-substituted thiazolidin-2-yl group (when R<sup>6</sup> is not H), which is a fully saturated heterocyclic group having the general structure:



or a thiazolin-2-yl group (when R<sup>6</sup> is H), which is a partially saturated heterocyclic ring having the structure:



Therefore, the compounds described in *Kaye* (thiazoles) can not anticipate the claimed compounds (thiazolines or thiazolidines). Based on the forgoing, Applicants request that the rejection be withdrawn.

### **Provisional Double Patenting**

The Examiner provisionally rejected claims 20-34 and 37 under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 33-46 and 53 of co-pending Application No. 11/914,992. Applicants respectfully request that the rejections be withdrawn in this application, which is the first-filed application. When the present claims are found allowable, the Examiner should assess whether the rejection could then be applied to the later-filed applications.

**Objections**

The Examiner objected to claims 20-34 and 37 for containing non-elected subject matter. Applicants believe that previously set forth rejections have been overcome. As such, Applicants respectfully request that the examination be expanded to encompass the remainder of the subject matter claimed.

**Rejoinder of Withdrawn Claims**

Claims 35 and 36 should be rejoined for substantive prosecution because they are directed to a method and depend from or otherwise contain all of the limitations of composition claim 20, which is considered to be allowable. Under MPEP 821.04(b), "if applicant elects a claim(s) directed to a product which is subsequently found allowable, withdrawn process claims which depend from or otherwise require all the limitations of an allowable product claim will be considered for rejoinder."

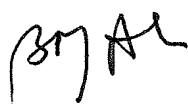
For the foregoing reasons, claims 20-34 and 37 are considered allowable. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

**The Director is hereby authorized to charge any appropriate fees that may be required by this paper, and to credit any overpayment, to Deposit Account No. 23-1925.**

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

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